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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/531,586

04/18/2005

Hansulrich Reisacher

270429US0PCT

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11/20/2008

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.  
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ALEXANDRIA, VA 22314

EXAMINER

ABU ALI, SHUANGYI

ART UNIT

PAPER NUMBER

1793

NOTIFICATION DATE

DELIVERY MODE

11/20/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/531,586	<b>Applicant(s)</b> REISACHER ET AL.	
	<b>Examiner</b> SHUANGYI ABU ALI	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 7-9 and 11-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-9 and 11-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of Claims***

Claims 7-9 and 11-15 remain for examination, and claim 16 is new.

### ***Claim Rejections - 35 USC § 103***

1) The rejection of claims 7-8 and 11-15 under 35 U.S.C. 103(a) as being unpatentable over U. S. patent No. 4,234,466 to Takahashi et al. as generally set forth in the previous office action mailed 04/14/2008 stands.

2) The rejection of claim 9 under 35 U.S.C. 103(a) as being unpatentable over combined teaching of U. S. patent No. 4,234,466 to Takahashi et al. and U. S. Patent No. 5,112,404 to Sommer et al. as generally set forth in the previous office action mailed 04/14/2008 stands.

The text of those sections of title 35 US Code not included in this action can be found in the prior Office Action.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. patent No. 4,234,466 to Takahashi et al.

The references differ from Applicant's recitations of claims by not disclosing identical ranges. However, the reference discloses "overlapping" ranges, and overlapping ranges have been held to establish prima facie obviousness (MPEP 2144.05).

Regarding claim 16, Takahashi et al. disclose a solid pigment comprising of 1-70% of pigment (col. 4, lines 9 and 10) and 27-96% at least one ethylenically unsaturated

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polymerisable compound (col. 3, lines 22 and 23) and 3-60% a resin (col. 3, lines 49 and 50).

When applicants contends that the modifying components in the reference are excluded by the recitation of “consisting essentially of”, applicants have the burden of showing the basic and novel characteristics of their composition – i.e. A showing that the introduction of these components would materially change the characteristics of the applicants’ composition. In re Delajarte, 337 F 2d 870, 143 USPQ 256 (CCPA 1964).

### ***Response to Arguments***

Applicant’s arguments, see page 5-6, filed 08/14/2008, with respect to the rejection of claim 7 under 35 U. S. C 112 have been fully considered and are persuasive. The rejection of claim 7 under 35 U.S. C 112 has been withdrawn.

Applicant's arguments filed 08/14/2008 with respect to the rejection of claims 7-9 and 11-15 under 35 U. S. C 103 has been fully considered but they are not persuasive.

1) Applicant argues that the prior art discloses that the pigment is encompassed in the resin. The Examiner respectfully submits that when the pigment is stirred or treated in the composition of the instant application, the pigment will be coated with the composition.

Applicants argue that the patent nowhere discloses the concept of combining a pigment with at least one water soluble anionic surface active agent. This is not persuasive because the reference clearly teaches a composition made up of (1) a pigment and (2) a polymer of ethylenically unsaturated monocarboxylic acid, thus the reference

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does teach the claimed composition and the examiner is unclear as to how applicants can make such a statement if the reference teaches all of the claimed components. Are applicants stating that the polymer is different? If so, what are the differences?

Applicant argues that the ethylenically unsaturated polymerisable compound of prior art is not a water soluble anionic surface active. The Examiner respectfully submits that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

2) Applicant argues that Sommer et al. and Takahashi et al. are not combinable. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner respectfully submits that Sommer et al. disclose that it is advantageous to use surfactant such as alkoxylation product of alkylphenols, fatty amine and et al. in an amount of 0-20%, in particular in an amount of 0-10% based on the weight of the pigment in the pigment preparation (col. 9 line 66 to col. 10. line 25). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

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See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHUANGYI ABU ALI whose telephone number is (571)272-6453. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael A Marcheschi/  
Primary Examiner, Art Unit 1793

sa